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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,578	02/27/2002	Takeshi Shibuya	ASA-1070	3832
24956	7590	12/14/2006	EXAMINER	
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			NAGPAUL, JYOTI	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/069,578

Applicant(s)

SHIBUYA ET AL.

Examiner

Jyoti Nagpaul

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-25 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 16-25 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Amendment filed on September 22, 2006 has been acknowledged. Claims 19-25 are pending.

#### ***Response to Amendment***

Rejection of Claims 2-11, 14 and 15 as being unpatentable over US patent 6,409,968 to Takahashi in view of Japanese patent 02066461 to Tanimizu et al. has been withdrawn in light applicants amendments.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 16-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to Claim 18, "a pretreatment rack" and "an aftertreatment rack" are not positively recited as components. Clarification is needed. With respect to Claim 21, "an emergency rack" and "the suspended rack" are not positively recited as components. Clarification is needed. With respect to Claim 21, "said analysis unit" is not positively recited as a component. Clarification is needed.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 1743

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 16-18 and 21-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Takahashi (US 6290907).

Takahashi teaches an automatic analyzer comprising a rack standby disk (301) capable of rotating and stopping in a state that a plurality of racks (10) holding specimens are made to standby thereon. A rack feed line (1a) for transferring the racks (10) from a rack supply section (2a) to the rack standby disk (301). The analyzer further comprising a rack recovery line (1b) for transferring the racks (10) on the rack standby disk (301) towards a rack recovery station (14) and a rack transfer means (1) operating to transfer the racks (10) from the rack standby disk (301) to a specimen sampling position (5) on an analysis unit and to return the racks (10), from which the specimens have been sampled in the specimen sampling position (5), to the rack standby disk (301). The analyzer further comprising a control unit (17) controlling transfer of the racks (10) such that when a specific rack, which holds a specific liquid to repeatedly sampled as necessary, is standing by on the rack standby disk (301), the specific rack is kept standing by on the rack standby disk until a subsequent time of measurement with the specific rack. (See Figures 1-6) Takahashi further teaches the rack standby disk (301) is disposed in a rack delivery unit (3). Takahashi further teaches wherein a position (1e) for receipt of a pretreatment rack from which a specimen is to be sample and a position (1e) for carrying-out of an aftertreatment rack from which a specimen has been sampled are used in common. (See Figure 1) Takahashi further teaches a control

Art Unit: 1743

unit (17) controlling transfer of the racks in a manner that after a preceding rack is returned to the rack standby disk (301) from the specimen sampling position (5), a subsequent rack is transferred via the track transfer means (1). (See Figure 1)

Takahashi further teaches the control unit (17) controls transfer of the racks (10) in a manner that when an emergency rack holding a specimen which needs urgent measurement, is received by the rack standby disk (301), a rack (10), for which sampling and treatment of a specimen is being performed in the analysis unit, is suspended in the treatment and temporarily returned onto the rack standby disk (301) and returned to the rack standby disk (301) after the sampling and treatment of the specimen, and then the suspended rack is transferred to the specimen sampling position (5) on the analysis unit from the rack standby disk (301) so that the sampling and treatment of the specimen are resumed for the suspended rack. (See Figure 1)

(Col. 5, Lines 21-56)

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 1743

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 19-20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi in view of Hanaway (US 4719087).

Takahashi fails to teach the rack standby disk is disposed in an evaporating protecting chamber, in which air is maintained higher in humidity than an outside air.

Hanaway teaches a specimen tray assembly for use in an automatic analyzer. The assembly comprising of an evaporation protecting chamber (See Figures 2, 4 and 5).

It would have been obvious to a person of ordinary skill in the art to modify the device of Takahashi such that the rack standby disk is disposed in an evaporating protecting chamber as suggested by Hanaway in order to reduce evaporation and there is no undue evaporation of the contents of the cuvettes. (See Col. 7, Lines 28-31)

***Response to Arguments***

Applicant's arguments with respect to claims 2-11, 14 and 15 have been considered but are moot in view of the new ground(s) of rejection. Applicants have canceled claims 2-11, 14 and 15 and have added new claims 16-25. A new rejection has applied on claims 16-25. Refer above.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyoti Nagpaul whose telephone number is 571-272-1273. The examiner can normally be reached on Monday thru Friday (8:00-4:30).

Art Unit: 1743

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JN

Jill Warden  
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